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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,103	10/09/2003	Dehou Fei		8125

7590 06/15/2007

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EXAMINER	
PAK, JOHN D	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
06/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/681,103	FEI ET AL.	
	Examiner	Art Unit	
	JOHN PAK	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-9* is/are pending in the application.

4a) Of the above claim(s) *7-9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5 and 6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20070531 and 20070613*
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

This Office action is in response to applicant's reply of 4/20/2007. Claims 1-4 have been canceled and claims 5-9 have been added.

Applicant is advised that this Office action is being made non-final. The Examiner stated during a telephone interview (see Interview Summary record of 6/7/2007) that this Office action would be made Final. Upon reconsideration, in view of the restriction requirement of record, it is believed that Finality would have been premature.

Applicant's election with traverse of the invention of Group III in the reply filed on 4/20/2007 is acknowledged. It is noted that Group IIII, as exactly set forth in the restriction requirement of 6/21/2005, is as follows:

> III. Claim 3, drawn to "Preventing more diseases and strengthening health more effectively: This health pill ..." It is noted that myriad diseases such as cancer, cardiovascular diseases and respiratory diseases are encompassed herein. This invention is classified in multiple subclasses in classes 424 and 514, depending on the chemical structure of the component ingredients.

Although claim 3 has been canceled due to multiple informalities (e.g. contains 3 sentences), the health pill is now claimed in new claims 5-6. Therefore, applicant's election is directed to Group III, claims 5-6.

The traversal is on the ground(s) that the liquid additive and the health pill are inseparable and interactive in rendering their functions. This is not found persuasive because of the following reasons.

(1) The health pill and liquid additive are claimed separately. See claims 5-6 (health pill) and claim 7 (liquid additive). There is nothing indicated in those claims that require a combination of the health pill and liquid additive. Pro se applicant is advised that it is the claims that get examined for patentability, not some unstated and/or unclaimed belief held by applicant.

(2) As currently and formerly claimed, the health pill and the liquid additive contain materially different ingredients. Some of the differences are noted below:

Content	Health Pill (elected)	Liquid Additive (non-elected)
Cerium dioxide	No	Yes
Sulfuric acid	No	Yes
Hydrogen peroxide	No	Yes
Potassium permanganate	No	Yes
Cupric sulfate	No	Yes
Cupric oxide	No	Yes
Activated Manganese dioxide	No	Yes
Vitamin E	Yes	No
Vitamin A	Yes	No
BHT	Yes	No
Riboflavin	Yes	No
Nicotinic acid	Yes	No
Pyridoxine hydrochloride	Yes	No

Therefore, as claimed by applicant originally and currently, the health pill and liquid additive are directed to independent and distinct inventions. The restriction between the two inventions is therefore proper.

(3) It is recognized that one aspect of applicant's invention is that the liquid additive and the health pill can work together to produce beneficial results. However, what applicant fails to appreciate is that the instant specification and claims have been written so that another aspect of the invention can be that the liquid additive and the health pill can be stand-alone inventions.

Assume that a hypothetical inventor invented a car with a novel and unobvious car engine and a novel and unobvious brake system. Suppose the hypothetical inventor filed a patent application in which a car is disclosed with the invention engine and invention brake system, but also suppose that patent application claims were filed with separate claims to the engine and separate claims to the brake system. In such a situation, since the engine and the brake system are not being claimed in one single claim together and there is nothing preventing the engine and brake system from being separately used, they can and would be considered separate inventions, which separate inventions are subject to a restriction requirement.

Applicant's situation here is analogous. It is applicant who presented claims, originally and currently, wherein the liquid additive and health pill are separately and

claimed[1]. Further, a health pill (elected invention) containing ingredients such as riboflavin, selenium and vitamins A, B_6 and E would be expected by the skilled artisan to have its own separate use, i.e. it does not necessarily require the use of the liquid pill in order to have some of its beneficial effects. That is sufficient to consider the health pill separately from the liquid additive under the facts of this case.

It is noted in this regard that the liquid additive claim 7 depends on the health pill claim 5. However, this is an improper claim dependency because those are two different compositions.

(4) As for claims 8 and 9, these claims are method claims that have absolutely no relationship between the health pill or the liquid additive of claims 5-7. In other words, claims 8 and 9 do not require the particulars of claims 5, 6 or 7. Therefore, the inventions of claims 8 and 9 are unrelated inventions and the unrelated inventions are properly restricted from the health pill and liquid additive inventions.

For these reasons, the requirement is still deemed proper and is therefore made FINAL. Accordingly, claims 7-9 are withdrawn from further consideration. Claims 5-6 will presently be examined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

[1] It is recognized that original claim 1 was drawn to a "liquid additive and a supplementary pill" but that claim did not specify any ingredients. As such, the invention of original claim 1 was independent and distinct from the inventions of original claims 2, 3 and 4.

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claim 5 recites "(ACA-1-4 2A)". This specific terminology was never before described in the originally filed disclosure. In view of the fact that applicant seems to associate certain meanings behind such product names, the new terminology is deemed to constitute new matter, which fails to find adequate written descriptive support from the originally filed disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) The term "(ACA-1-4 2A)" is confusing. No person skilled in the art would recognize what this term means.

(2) The parenthetical phrase, "(for 100 gram of tobacco, about 20 cigarettes x 6.667 packs)" is confusing. Keeping in mind that the independent claim 5 is claimed as "A health pill," it is confusing to further recite such parenthetical phrase.

It cannot be understood whether said parenthetical phrase means that the health pill is good for protective effects against 100 grams of tobacco or whether the health pill ingredients are to be divided up into multiple pills for the numbers of cigarettes that would contain 100 grams of tobacco.

If applicant intends that the ingredients and the amounts listed in the claims are meant to make, for example 4 pills, then such critical information should be expressly recited in the claims and the claim language modified to incorporate such inventive concept.

Also, "20 cigarettes x 6.667 packs" is a vague and imprecise terminology. It could mean 6.667 packs of cigarettes, each pack containing 20 cigarettes, but the language does not make it so clear.

(3) The " * " marks next to some of the ingredients in claims 5 and 6 render the claims indefinite. If applicant intends that ingredients with the * mark are to be considered to have certain properties, then applicant should positively recite that in the claims (without raising additional claim language problems).

(4) There should be an "and" after "Nicotinic acid" in claim 5.

(5) In claim 6, it is confusing to refer to the health pill of claim 5 and immediately thereafter recite a different product name, "(ACA-104 2B)."

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the fifth inventor did not sign and date the oath.

Applicant is advised to amend the specification as discussed in the Examiner's fax communication of 5/31/2007, which is incorporated herein by reference.

Applicant asked several questions in the fax of 6/7/2007 (see the Interview Summary record of 6/7/2007). Here are answers to applicant's questions that have not yet been addressed above.

(1) The deadline for filing a supplemental declaration with the fifth inventor's signature (and date of execution) is the time period for reply to this Office action.

(2) Footnotes cannot be part of any patent application claim language. Parenthetical information should also be avoided since all claim features must be positively recited.

(3) The content of the four pages of Appendix 2 should be in applicant's possession since these are pages from applicant's own specification. In the records before the USPTO, the four pages of Appendix 2 appear between pages 20 and 21 of the originally filed specification. Said four pages are in the Chinese language or contain English reference to tests disclosed in the Chinese language.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620.** The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Pak
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